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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/996,922	10/31/2001	David Michael Geshwind	SAT-A-DAY	3248

7590 09/27/2004
ANNE C. AVELLONE
60 WEST 66th St
New York, NY 10023

EXAMINER

HIRL, JOSEPH P

ART UNIT	PAPER NUMBER
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2121

DATE MAILED: 09/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/996,922

Applicant(s)

GESHWIND, DAVID MICHAEL

Examiner

Joseph P. Hirl

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-35 are pending in this application.

Claim Objections

2. Claim 32 is objected to because of the following:

Line 4, "as" is questionable and should be "at".

This objection must be corrected.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 11, 12, 13, 14, 25, and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "substantially" is relative and renders the claims indefinite.

5. Claim 29 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "extended" is a relative term and renders the claim indefinite.

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6. Claim 30 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "standardized" is a relative term and renders the claim indefinite.

7. Claim 32 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "required degree" is relative and renders the claim indefinite.

8. Claim 35 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "some" is a relative term and renders the claim indefinite.

9. Claims 32, 33, 34 and 35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "optionally" renders the claim ambiguous since the claim has at least two representations and therefore such claims are indefinite.

Claim Rejections - 35 USC § 101

10. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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11. Claims 1-9, 34 and 35 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The language of the claims raises a question as to whether the claims are directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101. The subject claims can be implemented with pencil and paper providing communication between participants or if all participants are in one room, the implementation is by voice. Specifically, the methodology or process is not embodied in a technological art.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13. Claims 1-35 are rejected under 35 U.S.C. 102(e) as being anticipated by Conklin et al (U.S. Patent 6,336,105, referred to as **Conklin**).

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Claim 1

Conklin anticipates a. at least one sponsor (**Conklin**, c 17, l 2-3); b. at least one student who receives motivation to utilize said educational materials in the form of an incentive provided by said sponsor on condition that said educational materials are utilized in a specified manner monitored by said provider (**Conklin**, c 19, l 1-14); and, c. said sponsor receives promotional value from providing said incentive (**Conklin**, c 19, l 1-14).

Examiner's Note (EN) : Applicant has disclosed a negotiating situation wherein there is a sponsor(s) process (including conditions), a seller process (authority selling means of improvement with conditions), and a buyer(s) process (authority buys product; student buys means of improvement by investing student's time with conditions). From Conklin, c 19, l 1-14, Fig. 1g provides the cited relationships.

Claim 2

Conklin anticipates said incentive comprises as least some discount on the acquisition of at least one product associated with said sponsor (**Conklin**, Fig. 1g; EN: incentives or discounts are part of the promotion process).

Claim 3

Conklin anticipates at least one sponsor comprises a multiplicity of sponsors (**Conklin**, Fig. 1c).

Claim 4

Conklin anticipates d. at least one authority (**Conklin**, Fig. 1g; EN: authority is both a buyer and a seller); e. said authority authorizes student participation (**Conklin**,

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Fig. 1g; EN: such is a seller qualifying a buyer); and, f. said authority receives the benefit of the increased likelihood of improved utilization by said student (**Conklin**, Fig. 1g; EN: such is a seller establishing terms with buyer and benefiting from the terms of the sale).

Claim 5

Conklin anticipates said authority is a parent of said student (**Conklin**, Fig. 1g; EN: such is the buyer and sell as identified in comments to claim 1).

Claim 6

Conklin anticipates said authority is an educator of said student (**Conklin**, Fig. 1g; EN: such is the buyer and sell as identified in comments to claim 1).

Claims 7, 8, 9

Conklin anticipates said sponsor provides compensation to the entity providing said educational materials (**Conklin**, Fig. 1g; EN: such is the collection of fees).

Claims 10, 11, 12, 13, 14

Conklin anticipates process of claim 2 (4, 7, 8, 9) is carried out, substantially in its entirety, in a computer-mediated manner (**Conklin**, Figs. 1).

Claim 15

Conklin anticipates the choice of which material is presented to a student at any given time is based on an assessment of prior student performance (**Conklin**, Fig. 1g; EN: conditions (terms) of sale from the authority to the student).

Claim 16

Conklin anticipates assessment is accomplished through the use of artificial intelligence computer techniques (**Conklin**, c 24, l 66-67, c 25, l 1-12; EN: AI broadly

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involves a learning process which is represented here by multivariate negotiations engine moving toward closure).

Claim 17

Conklin anticipates the choice of which material is presented to a student at any given time is varied from student to student for the purpose of discouraging students from not doing their own work (**Conklin**, Fig. 1g; EN: such is represented by the terms established between the authority and students (seller and buyer).

Claim 18

Conklin anticipates deceptive student activity is detected (**Conklin**, Fig. 1g; EN: such detection would be part of the service provided by the seller).

Claim 19

Conklin anticipates said deceptive student activity is detected by noting low accuracy and high speed of student participation (**Conklin**, Fig. 1g; EN: such detection would be part of the service provided by the seller).

Claim 20

Conklin anticipates said deceptive student activity is detected by comparing an image of said student's face to a computer database image (**Conklin**, Fig. 1g; EN: such detection would be part of the service provided by the seller).

Claim 21

Conklin anticipates said deceptive student activity is detected by computer monitoring of student interaction at the keyboard, and wherein said monitoring includes the analysis of time versus keystroke pattern for at least one previously-entered

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identifying phrase (**Conklin**, Fig. 1g; EN: such detection would be part of the service provided by the seller).

Claim 22

Conklin anticipates an image of said student's face is computer-monitored for the purposes of assessing student performance (**Conklin**, Fig. 1g; EN: such detection would be part of the service provided by the seller).

Claim 23

Conklin anticipates student interaction at the keyboard is computer-monitored for the purposes of assessing student performance, and wherein said monitoring includes the analysis of time versus keystroke pattern (**Conklin**, Fig. 1g; EN: such detection would be part of the service provided by the seller).

Claim 24

Conklin anticipates student performance and/or progress is reported (**Conklin**, Fig. 1g; EN: such detection would be part of the service provided by the seller where such progress is directly monitored on the computer terminal by the authority as work is being performed).

Claim 25

Conklin anticipates at least one element of said system operates, substantially in its entirety, via a computer network such as the Internet (**Conklin**, Fig. 2a).

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Claim 26

Conklin anticipates at least one element of said system operates, substantially in its entirety, via automated voice response and telephone keypad entry (**Conklin**, c 31, l 26).

Claim 27

Conklin anticipates student-to-student electronic communication (**Conklin**, c 31, l 22-34; EN: student to student is peer to peer which is represented by P1 to P2).

Claim 28

Conklin anticipates electronic communication between student and educator (**Conklin**, c 31, l 26; EN: educator is authority).

Claim 29

Conklin anticipates said educational materials comprise a series of sessions encountered over an extended period of time (**Conklin**, c 25, l 25-26; EN: buyers preferences for shipment (schedule) will set the period of time).

Claims 30, 31

Conklin anticipates said educational materials comprise a series of practice sessions for a standardized exam (**Conklin**, c 28, l 20-34; EN: such are standardized rules in a community and practice is the process of becoming familiar with such rules).

Claim 32

Conklin anticipates a. a provider supplies educational material comprising a series of computer mediated sessions (**Conklin**, Figs. 1; EN: supplier is a seller); b. a student accesses said educational materials to a required degree as assessed by said

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provider (**Conklin**, Fig. 1g; EN: student is a buyer); c. a sponsor provides motivation to the student to meet said required degree of access by supplying as least some discount on the acquisition of some product associated with said sponsor; (**Conklin**, Fig. 1g; EN: such motivation is promotion); d. sponsor receives promotional value from said acquisition (**Conklin**, Fig. 1g); and, e. provider, optionally, receives compensation from said sponsor (**Conklin**, Fig. 1g; EN: provider is a seller and promotional fees can be part of the deal).

Claim 33

Conklin anticipates f. a parent receives the benefit of the increased likelihood of improved utilization of said educational materials by said student (**Conklin**, Fig. 1g; EN: a parent is authority and such is compensation from the sale); and, g. provider, optionally, receives compensation from said parent (**Conklin**, Fig. 1g; EN: provider is a seller and promotional fees can be part of the deal).

Claim 34

Conklin anticipates a. the incorporation of an artificial intelligent engine and/or expert 'instructional media designer' system into a first phase wherein said system interacts with an author/teacher (**Conklin**, c 24, l 66-67, c 25, l 1-12; EN: AI broadly involves a learning process which is represented here by multivariate negotiations engine moving toward closure which can be the first phase in the procurement process wherein the author teacher is a seller); b. said system makes preliminary suggestions to said author/teacher regarding segmenting and organizing domain specific knowledge base elements (**Conklin**, c 24, l 66-67, c 25, l 1-12; EN: such system involves

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suggestion of different terms); c. said author/teacher provides media files and organizational, structural, interconnection and/or labeling information, to said system (**Conklin**, c 24, l 66-67, c 25, l 1-12; EN: such system involves suggestion of alternative terms); d. said system analyzes the information input in step c. and makes additional suggestions to, and requests of, said author/teacher (**Conklin**, c 24, l 66-67, c 25, l 1-12; EN: such system involves suggestion of alternative terms); e. said author/teacher optionally provides additional media files and organizational, structural, interconnection and/or labeling information, in response to step d (**Conklin**, c 24, l 66-67, c 25, l 1-12; EN: such system involves suggestion of alternative terms required to move closer to closure); f. said system presents a draft presentation for review by said author/teacher (**Conklin**, c 25, l 13-17); g. said author/teacher optionally makes adjustments in response to step f. (**Conklin**, c 25, l 13-17); and, h. said system outputs final draft as labeled media and interactive scripts (**Conklin**, c 25, l 13-17; c 2, l 33-45).

Claim 35

Conklin anticipates a. the incorporation of an artificial intelligent engine and/or expert 'teacher' system into a second presentation/learning phase wherein said system interacts with a student user (**Conklin**, c 24, l 66-67, c 25, l 1-12; EN: AI broadly involves a learning process which is represented here by multivariate negotiations engine moving toward closure which can be the first phase in the procurement process wherein the student/user a buyer); b. said system presents material in a default mode or, if available, in a mode dictated by a student profile/history and the type of material as indicated by pedagogical and cognitive labels supplied during said first phase (**Conklin**,

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c 25, l 13-18; EN: student is a buyer and past relationship history is available to the deciding entity); c. student interacts with material, including optional assessment (**Conklin**, c 25, l 13-18); d. said system analyzes student answers to said assessment (**Conklin**, c 24, l 66-67, c 25, l 1-12); e. said system repeats or adds material and assessment as needed per analysis of step d (**Conklin**, c 24, l 66-67, c 25, l 1-12); f. said system optionally analyzes keyboard and mouse dynamics to determine level of said student interest, and/or level of attention (**Conklin**, Fig. 1g; EN: such analysis would be part of the service provided by the seller); g. said system optionally analyzes student voice and/or face to determine level of said student interest and/or level of attention (**Conklin**, Fig. 1g; EN: such analysis would be part of the service provided by the seller); h. said student optionally makes explicit requests to adjust level of detail or complexity, speed of presentation and/or type of media (**Conklin**, Fig. 1g; EN: such request by buyer would be part of the service provided by the seller); i. said student optionally makes explicit requests, or for additional information via several types of help requests **Conklin**, Fig. 1g; EN: such request by buyer would be part of the service provided by the seller); j. said system adjusts level of detail or complexity, and/or type of media of presentation based on some combination of analyses in previous steps(**Conklin**, c 24, l 66-67, c 25, l 1-12); and, k. said system updates student profile based on performance and pedagogical and cognitive labels generated in said first phase (**Conklin**, c 24, l 66-67, c 25, l 1-12; EN: such is the process of moving to closure).

Examination Considerations

14. The claims and only the claims form the metes and bounds of the invention.

"Office personnel are to give the claims their broadest reasonable interpretation in light of the supporting disclosure. *In re Morris*, 127 F.3d 1048, 1054-55, 44USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim are not read into the claim. *In re Prater*, 415 F.2d, 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969)" (MPEP p 2100-8, c 2, I 45-48; p 2100-9, c 1, I 1-4). The Examiner has full latitude to interpret each claim in the broadest reasonable sense. Examiner will reference prior art using terminology familiar to one of ordinary skill in the art. Such an approach is broad in concept and can be either explicit or implicit in meaning.

15. Examiner's Notes are provided to assist the applicant to better understand the nature of the prior art, application of such prior art and, as appropriate, to further indicate other prior art that maybe applied in other office actions. Such comments are entirely consistent with the intent and spirit of compact prosecution. However, and unless otherwise stated, the Examiner's Notes are not prior art but a link to prior art that one of ordinary skill in the art would find inherently appropriate.

16. Examiner's Opinion: Paras 14. and 15. apply. The Examiner has the obligation and has full latitude to interpret each claim in the broadest reasonable sense. Hence the "shell" concept of negotiations applies in anticipation of the inventors disclosure.

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Conclusion

17. The prior art of record and not relied upon is considered pertinent to applicant's disclosure.

- Hastings, U.S. Patent 6,751,596
- Koopersmith, U.S. Pub. 2001/0042002
- Erturk et al, U.S. Patent 6,135,776
- Mathews, U.S. Patent 6,041,303

18. Claims 1-35 are rejected.

Correspondence Information

Any inquiry concerning this information or related to the subject disclosure should be directed to the Examiner, Joseph P. Hirl, whose telephone number is (703) 305-1668. The Examiner can be reached on Monday – Thursday from 6:00 a.m. to 4:30 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Anthony Knight can be reached at (703) 308-3179.

Any response to this office action should be mailed to:

Commissioner of Patents and Trademarks,

Washington, D. C. 20231;

or faxed to:

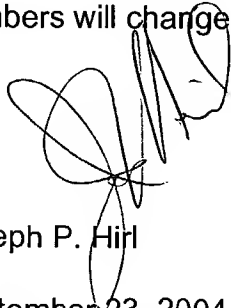
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(703) 746-7239 (for formal communications intended for entry);

or faxed to:

(703) 746-7290 (for informal or draft communications with notation of
"Proposed" or "Draft" for the desk of the Examiner).

Note: During the last two weeks of October 2004, Art Unit 2121 will move to
Carlyle, Randolph Building, 5th floor and my phone and fax number will change to: 571-
272-3685 and 571-273-3685, respectively. Similarly, Anthony Knight's phone and fax
numbers will change to: 571-272-3687 and 571-273-3687.

A handwritten signature in black ink, appearing to read 'Joseph P. Hirl', is written over the printed name.

Joseph P. Hirl

September 23, 2004